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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,133	08/02/2005	Takeshi Azami	P8375.0003	7710
32172 7590 10/01/2008 DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714				
EXAMINER				
MCCRACKEN, DANIEL				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
10/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/544,133

**Applicant(s)**

AZAMI ET AL.

**Examiner**

DANIEL C. MCCracken

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Citation to the Specification will be in the following format: (S. # : ¶/L) where # denotes the page number and ¶/L denotes the paragraph number or line number. Citation to patent literature will be in the form (Inventor # : LL) where # is the column number and LL is the line number. Citation to the pre-grant publication literature will be in the following format (Inventor # : ¶) where # denotes the page number and ¶ denotes the paragraph number.

### ***Response to Arguments***

Applicant's arguments filed 6/30/2008 have been fully considered but they are not persuasive. Applicant's traversal is on the alleged failure of Withers and Ullmann to teach "flattening the surface of said graphite target." (Remarks of 6/30/2008 at 6). The plain language of Claims 8-10 (*i.e.* the independent method claims) states that flattening the graphite target is accomplished with irradiated light (*i.e.* a laser). *See* (Claim 8) ("flattened with light"). Withers (as noted in the non-final rejection and as recognized by Applicants) teaches a laser and irradiating a target with a laser. (Withers 8: 29-50, "Fig. 8"). Given that laser irradiation is claimed and laser irradiation is taught, it is expected that this "flattening" phenomena is necessarily present. To argue the contrary as Applicants have is a tacit admission that their invention is inoperable, non-enabled, or both. As such, the Examiner reserves the right to make rejections under 35 U.S.C. §§101, 112 as appropriate. Given that a laser is taught, the "unit for flattening the surface" limitation of independent Claims 1-3 is met.

*If Applicants mean something different (cutting, grinding or polishing), this should be explicit in the claim language. The Examiner will not import unclaimed embodiments into the*

claims to give them meaning, especially with the ambiguities present in the claim as drafted. Perhaps inserting punctuation or deleting terms from the claims would better express the meaning which appears to be argued; for example it may be better if in claim 8 “flattening the surface of said graphite target irradiated with light” seems to imply that flattening is caused by irradiation, and that ‘irradiated with light’ is best deleted from the claim. Note however that adding limitations related to grinding, etc. may not be of patentable significance. This technique is likewise taught in Withers. *See* (Withers “Fig. 16,” 13: 16-22) (“Doctor Blade,” note that it explicitly recites “smoothing”). This concept is also taught in the Ohshima reference on Applicants IDS (JP 2001-80912). As the Examiner does not read or speak Japanese, Applicants (or at least their American counsel) are directed to US 5,587,141 to Ohshima. *See* (Ohshima “Figs” and 3: 29) (scraping member). These “doctor blades” appear to be exactly what Applicants *might* be describing but not claiming. *Compare* (Withers “Fig. 16,” 13: 16-22) *with* (S. 26: 24-25; “Fig. 5”) (“cutting tool”). Stated another way, the skilled artisan is well aware (Ohshima issued in the USA in 1996, Withers in 1999) of “flattening” techniques as applied to continuous (*i.e.* rotating) fullerene (read “nanocarbon”) synthesis techniques.

No other arguments – as required by 37 C.F.R. 1.111(b) – were presented. The rejections are MAINTAINED.

***Claim Rejections - 35 USC § 103***

**The rejections as set forth in the non-final office action dated 4/2/2008 are expressly incorporated herein by reference.**

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

All amendments made in response to this Office Action must be accompanied by a pinpoint citation to the Specification (i.e. page and paragraph or line number) to indicate where Applicants are drawing their support.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MCCracken whose telephone number is (571)272-6537. The examiner can normally be reached on Monday through Friday, 9 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel C. McCracken/  
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